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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/759,766	01/12/2001	Mohsen Shahinpoor	2359-00	4964

7590 05/17/2005

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EXAMINER

BLANCO, JAVIER G

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 05/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/759,766

Applicant(s)

SHAHINPOOR ET AL.

Examiner

Javier G. Blanco

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 3,7-9 and 11 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 12 is/are allowed.
- 6) ☒ Claim(s) 1,2,4-6,10 and 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 14, 2005 has been entered.

Response to Amendment

2. Applicants' cancellation of claims 14-20 in the reply filed on March 14, 2005 is acknowledged.
3. Applicants' amendment of claims 1 and 13 in the reply filed on March 14, 2005 is acknowledged.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1, 2, 4-6, and 10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the

Art Unit: 3738

relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

a. Regarding claim 1, newly added claim limitation “a means for transmitting a contraction force from the ciliary muscles to the at least one set of natural zonular fibers” (see lines 5-6) was not disclosed/described/suggested in the specification. The figures do not show said “means for transmitting” either. Claims 2, 4-6, and 10 depend on claim 1.

Because of the procedure outlined in M.P.E.P. 2163.06 for interpreting the claims, it is noted that other art may be applicable under 35 U.S.C. 102 or 35 U.S.C. 103(a) once the aforementioned problem is corrected.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Regarding claim 13, the limitation “the natural crystalline eye lens comprises an implanted lens” (see lines 1-2) is vague and indefinite as to the scope of the invention. Does it mean that the “natural crystalline eye lens” is an “implanted lens”? Does it mean that, in addition to the “natural crystalline eye lens”, there is also an implanted lens?

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

9. Claims 1, 2, 4-6, and 10 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Ganem et al. (CA 2 358 485 A1).

Referring to Figures 1, 2, and 4, Ganem et al. disclose an apparatus *for* augmenting near vision accommodation by contraction of the ciliary muscles by contraction of the ciliary muscles of the eye by reinforcement (see page 1, lines 15-18 and lines 22-24) of at least one set of natural zonular fibers, the apparatus comprising at least one bridge (ring or device 20) *configured to be* affixed (see Figure 2) in and around the at least one set of natural zonular fibers, wherein said at least one bridge transmit an augmented contraction force for constricting the natural crystalline lens by the augmented contraction force from the ciliary muscles to the at least one set of zonular fibers and the at least one bridge (see page 2, lines 3-6; see claim 1).

Response to Arguments

10. Applicants' arguments filed March 14, 2005 have been fully considered but they are not persuasive. Applicants argue "Claim 12 was allowed, thus the features of claim 12 were added to claim 1 to make claim 1 allowable" (see Remarks at page 7, first paragraph). Examiner respectfully disagrees.

Art Unit: 3738

Claim 12 is a method claim wherein each step limitations and functional language limitations are given patentable weight. Claim 1 is an apparatus claim. The intended use recitations (e.g., "for augmenting", "configured to be affixed", etc.) carry no patentable weight in the absence of any distinguishing structure. Ganem et al. disclose the structure (and intended use) as claimed and is found to be inherently capable of performing the function.

a. Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA1959).

"[A]pparatus claims cover what a device is, not what a device does." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990).

Allowable Subject Matter

11. Claim 12 is allowed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Javier G. Blanco whose telephone number is 571-272-4747. The examiner can normally be reached on M-F (7:30 a.m.-4:00 p.m.), first Friday of the bi-week off.

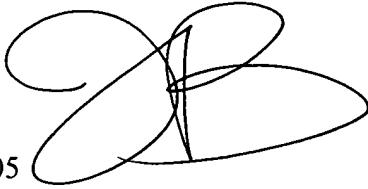
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone numbers for the organization where this application or proceeding is assigned is 703-872-9306 for regular communications and After Final communications. Any inquiry of a general nature or relating to

Art Unit: 3738

the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

JGB

May 13, 2005

A handwritten signature consisting of a large, stylized 'J' and 'G' intertwined, with a vertical line through the center.A handwritten signature consisting of a stylized 'C' followed by a long horizontal line and a small '2' at the end.

CORRINE McDERMOTT
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700